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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,858	02/10/2004	Joseph Mulvey	UWP1P061C1/3101C1	1487
26528	7590	07/10/2006	EXAMINER	
TOWNSEND TOWNSEND AND CREW LLP TWO EMBARCADERO CETNER, EIGHTH FLOOR SAN FRANCISCO, CA 94111			BAUTISTA, XIOMARA L	
			ART UNIT	PAPER NUMBER
			2179	

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/775,858	Applicant(s) MULVEY ET AL.	
	Examiner X. L. Bautista	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-12,15,17-19 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-12,15,17-19,23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see amendment, filed 5/1/06, with respect to the rejection(s) of claim(s) 1-22 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of *Robinson et al* and *Riskin*.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-3, 6-12, 15, 17-19 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Robinson et al* (US 6,801,190 B1) and *Riskin* (US 5,031,206).**

Claims 1, 6, 7, 10-12, 17, 18, 23, 25 and 26:

Robinson discloses a keyboard system with automatic correction. The system predicts an entry and provides users with an additional item of alphanumeric

information as candidate information (abstract; col. 3, lines 13-59). Robinson teaches that the system determines whether the presented candidate information is accepted or unaccepted after a predetermined threshold period of time (col. 9, lines 19-67, 49-57; col. 10, lines 14-57).

Robinson teaches that the system takes into consideration the user's actions to determine predictions but it does not teach that the system characterizes a predicted item as unacceptable to the user when the user does not provide input during a predetermined time period. However, Riskin discloses a method of identifying or guessing words from letters entered on a DTMF (Dual Tone Multi-Frequency) pushbutton pad (abstract; col. 2, lines 23-68; col. 3, lines 1-5; col. 5, lines 44-68; col. 7, lines 36-45, 64-68; col. 8, lines 1-12, 28-50; col. 14, lines 7-15). Riskin teaches that the user may reject or accept a word and explains that the system waits a time-out period for a reject; if the user rejects the provided choice, the system then provides another choice; and if no reject is received before the time expires, the system assumes the word was correct; if the # button is pushed after the timer expires, that is, the system cancels the word (the system characterizes the word as unacceptable). The system provides a first choice, if the choice is not accepted then the system provides another choice until there are no more words available in the dictionary that match the current string; and when no rejection is received before the time expires the system assumes the word was correct; and if

the # button is pressed (user entry) after the time expires, the system determines that the prediction has to be canceled. In short, Riskin teaches the use of a timer for determining the user's actions and making decisions based on receiving an input before or after the timer expires. Riskin does not specifically teach using a timer for canceling a suggestion when no user entry is received after a period of time. However, it would have been obvious to modify Robinson based on Riskin's teaching of a timer to include a timer for the system to determine that a prediction is not useful for the user and store it in a file or discard it because the user just has to keep typing more letters until getting the right suggestion without being forced to make a selection every time he/she is provided with a new prediction; and also because if the user leaves the device for a long period of time the display is refreshed after the last suggestion is cleared.

Claim 2:

Robinson teaches a keypad key assertion (col. 10, lines 16-24).

Claims 3 and 24:

Robinson teaches prediction of additional items based upon a personal context model as corresponds to the user (col. 9, lines 19-67).

Claims 8 and 9:

See claim 1. Robinson/Riskin teaches setting a timer based on the user's actions (user's characteristics); a timer that is used to determine the user's

acceptance or rejection of a suggested object; and a system that determines and utilizes the time the user uses to respond to a prediction and automatically sets a new period of time based on that time (Robinson: col. 9, lines 19-67, 49-57; col. 10, lines 14-57; Riskin: col. 24, lines 49-65).

Claims 15 and 19:

See claim 1. Robinson teaches that the user can configure the system so that predicted words are presented with (different visual appearance) special coloration or highlighting (col. 30, lines 1-5).

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to X. L. Bautista whose telephone number is (571) 272-4132. The examiner can normally be reached on Monday-Thursday 8:00AM-6:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the

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automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-
272-1000.



X. L. Bautista
Primary Examiner
Art Unit 2179

xlb
June 29, 2006